

communication passageway 16 extending from the barrier 15 to the other end of the elongated member 12. External openings 18 are provided adjacent to the first end of the elongated member 12 for dispensing diagnostic fluid into the uterine cavity. An opening 23 in passageway 13 just before the barrier 15 allows fluid communication between fluid communication passageway 13 and a balloon cavity 24 of an inflatable balloon 20. The barrier 15 includes an opening 26' which allows fluid communication between fluid communication passageway 16 and fluid communication passageway 13. The opening 26' in the barrier 15 has a diameter which is much smaller than opening 23 so that the opening 26' forms a restriction which allows the balloon 20 to inflate as flow goes through opening 26', not the external openings 18.

In support of the rejection, the examiner states that:

...it would have been obvious to reposition the reduced diameter portion inside the lumen into any position along the lumen distal to the opening into the balloon (second opening) and proximal to the openings adjacent the distal end (external openings). Furthermore, the reduced diameter portion could be incorporated immediately adjacent to or integral with the external openings and still provide the same function...Any individual skilled in the art of fluid dynamics would recognize this fluid flow property. Positioning the flow restrictor (26' see figure 7) integral with the external openings of Valtchev would be a design modification consistent with the teachings of Valtchev and would not alter the function or performance of the device. The motivation for this alternative design choice can be found in Valtchev column 3 lines 24-31 which states "[o]bviously, many modifications and variations of the present invention are possible...the invention may be practiced otherwise than as specifically described".

The examiner's rationale basically amounts to the contention that although Valtchev does not teach the claimed structure it is possible to modify Valtchev to arrive at the claimed structure. However, the mere fact that a reference can be modified does not render such a modification obvious unless the prior art also suggests the desirability of the modification. See *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990), and *In re Fritch*, 972 F.2d 1260, 23

USPQ2d 1780 (Fed. Cir. 1992). Moreover, the fact that the any person skilled in fluid dynamics would recognize that the barrier could be placed elsewhere is not by itself sufficient to establish *Prima Facie* obviousness. See *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993), and *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000).

The “boilerplate” statement at the end of the Valtchev, which is relied upon by the examiner for suggesting the modification proposed by the examiner, does not contain any language which teaches or suggests the desirability of eliminating the barrier 15 and modifying the external openings 18 to generate a back-flow within passageway 13 that causes the fluid to enter and inflate balloon 20 through opening 23.

In view of the foregoing, withdrawal of the rejection under 35 USC 103 (a) is respectfully urged.

Claims 1-16 and 22-23 (actually claims 1-7, 9, 11-16, 22, and 23) stand rejected under 35 USC 103 (a) as being unpatentable over U.S. Patent 5,624,399 to Ackerman in view of Valtchev.

Claims 1 and 9 both call for the external opening adjacent the first end (of the tubular body or catheter) to generate a back-flow within the lumen which causes the fluid to enter and inflate the balloon through the second opening (which is in communication with the interior of the balloon). The arguments set forth above against Valtchev are incorporated herein by reference. The addition of Ackerman (which merely teaches a double-lumen, intracervical/intrauterine catheter device wherein one of the lumens allows the dispensing of a diagnostic fluid into the uterine cavity and the other one provides a communication passageway for inflating the balloon) still fails to establish a *prima facie* case of obviousness of the invention. This is because Ackerman in view of Valtchev fail to teach or suggest the claimed external opening, which generates a back-flow within the lumen that causes fluid to enter and inflate the

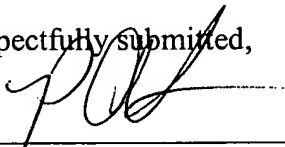
balloon through a second opening in the lumen. Moreover, for the same reasons as stated above with regard to the previous rejection, no motivation exists in the prior art for modifying the structure of Ackerman in view of Valtchev to arrive at the claimed external opening structure.

Because Ackerman in view of Valtchev fail to teach or suggest all the structural limitations of the claims, withdrawal of the rejection under 35 USC 103 (a) is respectfully urged.

Favorable reconsideration of this application is respectfully requested as it is believed that all outstanding issues have been addressed herein and, further, that claims 1-7, 9, 11-16, 22, and 23 are in condition for allowance, early notification of which is earnestly solicited. Should there be any questions or other matters whose resolution may be advanced by a telephone call, the Examiner is cordially invited to contact Applicant's undersigned attorney at his number listed below.

No fee is believed to be due as a result of this communication. The Commissioner is hereby authorized to charge any other fees which may be required or credit any overpayment to Deposit Account No. Deposit Account No. 50-2061.

Respectfully submitted,



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